

REMARKS

In the Office Action, the Examiner indicates that claims 1-15, 17-19, 22-24, 28-30, 34-44 and 46-48 are pending in the application. No new matter is included in this Amendment.

The First 35 U.S.C. §103(a) Rejection:

At page 3 of the Office Action, claims 1-4, 11,14 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,875,164 to Yamakawa et al. in view of U.S. Patent 6,021,102 to Seto et al., U.S. Patent 6,119,262 to Chang et al. and U. S. Patent 5,699,434 to Hogan. This rejection is respectfully traversed.

A Declaration under 37 C.F.R. §1.131(a), declaring an earlier date of invention prior to August 19, 1997 was submitted on June 27, 2003. The U.S. filing date of Chang et al. is August 19, 1997 and the U.S. filing date of Seto et al. is August 21, 1997. Based on the §1.131(a) Declaration, it is submitted that neither Chang et al. nor Seto et al. is a valid reference against the present application.

At page 2 of the present Office Action, the Examiner asserts that the Applicant's 37 C.F.R. §1.131 Declaration submitted on August 27, 2003 is ineffective to overcome the Chang et al. and Seto et al. references, asserting that diligence must be shown from the filing date of the Korean Priority Document to the U.S. filing date. (The Declaration was first submitted with a response filed June 27, 2003. A copy of the Declaration was submitted on August 27, 2003 because the Declaration submitted on June 27, 2003 had apparently become lost in the USPTO.) The Examiner quotes MPEP 715.07(a) in support of the assertion of the ineffectiveness of the Declaration.

"Under [37] CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing of a United States Patent Application)."

According to 37 CFR 1.131,

"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or

to the filing of the application."

The Examiner states that the "declaration provides a timeline of activities showing diligence from a date prior to the 'date of reduction to practice' of the Chang et al. and Seto et al. references to the filing date of the Korean Priority document, however the time line fails to show diligence to either a constructive reduction to practice or an actual reduction to practice."

The meaning of the term "to the filing of the application" clearly means the filing date of the application. Further, the present application is clearly entitled to the benefit of 35 U.S.C. §119. A timely claim for such priority was filed concurrently with the U.S. Patent application and the Examiner has acknowledged such claim for priority and notes that certified copies of the priority documents have been received. Under 35 U.S.C. §119, an application qualifying for priority "shall have the same effect as the same application would have if filed in this country on the date on which application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed..."

The Korean application corresponding to the priority document was filed on August 30, 1997 and the U.S. application was filed on August 10, 1998, thus the U.S. application was filed within 12 months of the Korean application and is thus entitled to the benefit of 35 U.S.C. §119. An effect of filing a U.S. application is to provide a constructive reduction to practice, thus an effect of filing a Korean application entitled to the benefits of 35 U.S.C. §119 is also a constructive reduction to practice. To hold otherwise, the provisions of 35 U.S.C. §119 that the application "shall have the same effect as the same application would have if filed in this country on the date on which application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed" would have to be completely ignored. See *In re Mulder and Wulms*, 219 USPQ 189, 193 (CAFC 1983).

It is respectfully submitted that the Examiner is in error in concluding that the Declaration under 37 C.F.R. §1.131 submitted by the Applicant is ineffective to overcome the Chang et al. and Seto et al. references.

It is respectfully requested that the rejection of claims 1-4, 11,14 and 37-38 be withdrawn.

The Second 35 U.S.C. §103(a) Rejection:

At page 5 of the Office Action, claims 7, 10, 12, 15, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,875,164 to Yamakawa et al. in view of U.S. Patent 6,021,102 to Seto et al. and U.S. Patent 6,119,262 to Chang et al. This rejection is respectfully traversed.

For reasons set forth above regarding "The First 35 U.S.C. §103(a) Rejection," it is submitted that neither Chang et al. nor Seto et al. is a valid reference against the present application. It is respectfully requested that the rejection of claims 7, 10, 12, 15 and 43 be withdrawn.

The Third 35 U.S.C. §103(a) Rejection

At page 6 of the Office Action, claims 17, 22-24, 28-30, 34-36 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,875,164 to Yamakawa et al. in view of U.S. Patent 6,119,262 to Chang et al.

For reasons set forth above regarding "The First 35 U.S.C. §103(a) Rejection," it is submitted that Chang et al. is not a valid reference against the present application. It is respectfully requested that the rejection of claims 17, 22-24, 28-30, 34-36 and 46 be withdrawn.

The Fourth 35 U.S.C. §103(a) Rejection

At page 7 of the Office Action, claims 18 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,875,164 to Yamakawa et al. in view of U.S. Patent 5,699,434 to Hogan. Claim 18 is deemed to be patentable at least for similar reasons set forth above regarding claim 17 and claim 47 is deemed to be patentable at least for similar reasons set forth above regarding claim 46.

The Fifth 35 U.S.C. §103(a) Rejection

At page 9 of the Office Action, claims 19 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,875,164 to Yamakawa et al. in view of U.S. Patent 6,021,102 to Seto et al.

For reasons set forth above regarding "The First 35 U.S.C. §103(a) Rejection," it is submitted that Seto et al. is not a valid reference against the present application. It is respectfully requested that the rejection of claims 19 and 48 be withdrawn.

Allowable Subject Matter:

At page 8 of the Office Action, the Examiner indicates that claims 39-42 and 44 are allowed and that claims 5, 6, 8, 9 and 13 are objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Conclusion:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 11/25/03

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